

REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Currently, claims 74-112 remain pending in the present application, including independent claims 74, 94, and 107. Independent claim 74, for instance, is directed to a carpet comprising a primary backing and a piling yarn inserted therethrough. The primary backing consists essentially of a woven fabric having warp and fill yarns needlepunched to a bonded nonwoven fabric. The backing has a dimensional stability of about 3 pounds to about 20 pounds, wherein the dimensional stability is determined by grabbing and pulling the backing at a 45 degree angle in relation to the warp and fill yarns of the backing such that the backing incurs approximately a 5% elongation.

In the Office Action, original independent claims 50, 66, and 73 were rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, obvious under 35 U.S.C. §103(a) in view of U.S. Patent No. 4,242,394 to Lieb, et al. Lieb, et al. is directed to a reinforced primary backing designed to eliminate the need for a secondary backing. For example, as shown in the Figure, the primary backing 4 of Lieb, et al. includes a non-woven fibrous capping layer 6, conventionally needled into and through reinforcing material layer 8 and continuing through woven backing layer 10. (Col 2, ll. 33-38). The capping layer 6 can be a layer of any suitable staple fibers. (Col 2, ll. 43-44). The reinforcing material layer 8 can be any suitable natural, semisynthetic, synthetic, or metallic fiber scrim. Also suitable for the reinforcing material layer 8 are spunbonded fibrous sheets. (Col 2, ll. 48-60). The backing layer 10 can be any

conventional woven backing scrim comprising synthetic or natural fibers. (Col 2, ll. 64-65).

As indicated above, Lieb, et al. expressly requires the use of three (3) layers to achieve the primary backing, i.e., a capping layer of staple fibers, a reinforcing material layer, and a woven backing layer. To the contrary, independent claims 74, 94, and 107 require a primary backing that "consists essentially of" only two (2) fibrous layers, i.e., a woven fabric and a bonded nonwoven fabric. At least because the present claims exclude the presence of a third fibrous layer as required by Lieb, et al., Applicants respectfully submit that independent claims 74, 94, and 107 are not anticipated by Lieb, et al.

In addition, Applicants also respectfully submit that independent claims 74, 94, and 107 are not obvious in view of Lieb, et al. Namely, no motivation would have existed for one of ordinary skill in the art to remove only 1 of the 3 layers of the primary backing of Lieb, et al. Lieb, et al. repeatedly refers to each layer as forming an integral and necessary part of the primary backing. For instance, Lieb, et al. states that "[a]ccording to this invention, there is provided a reinforced primary backing for tufted pile fabric comprising a non-woven fibrous capping layer, a reinforcing material layer and a woven backing layer." (Col 1, ll. 28-31). Lieb, et al. further emphasizes that the non-woven capping layer must be needled into and extend downward through the reinforcing layer and the woven backing layer. (Col 1, ll. 35-40). Thus, a modification of Lieb, et al. to remove only 1 of the 3 layers of the primary backing would simply contradict the express teachings of Lieb, et al.

Besides failing to disclose or suggest the limitations discussed above, Lieb, et al. also fails to disclose or suggest other limitations of independent claims 74, 94, and 107. For instance, each independent claim requires that the primary backing have a dimensional stability from about 3 to about 20 pounds. As correctly noted by the Examiner, Lieb, et al. fails to disclose such a dimensional stability. Nevertheless, it was presumed in the Office Action that the claimed dimensional stability limitation was inherent in Lieb, et al. Support for this presumption was said to stem from the use of like materials and like processes.

To establish inherency, the evidence must make clear that the missing descriptive matter is necessarily present in the reference, and that it would be so recognized by persons of ordinary skill in the art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Thus, an inherency rejection may not be based on what would result due to the optimization of conditions, but only on what was necessarily present in the prior art.

In the instance case, a variety of factors may be altered to influence the dimensional stability, such as the types of components utilized, the weight ratio of the components, the needling process, and the like. For example, in the present invention, the amount of needling (e.g., the strokes per minute of the needles, the degree of penetration of the needles, and/or the advance rate of the components) may be adjusted to optimize the strength and adhesion characteristics of the carpet backing. (Appl. pp. 11-12). Thus, to obtain the claimed dimensional stability limitation from Lieb, et al., one of ordinary skill would have to select from various possible conditions and

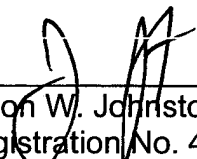
parameters. For example, to achieve the dimensional stability required in independent claims 74, 94, and 107, one would have to select the appropriate weight ratios, type of components, needling amounts, and/or other appropriate values. Consequently, Applicants respectfully submit that the claimed dimensional stability limitation does not necessarily flow from the teachings of Lieb, et al.

In summary, Applicants respectfully submit that the present claims patentably define over all of the prior art of record for at least the reasons set forth above. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Juska is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

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